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EXAMINER

FLANDRO, RYAN M

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 07/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/027,502

Applicant(s)

MOSING, DONALD E.

Examiner

Ryan M Flandro

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-16, and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Objections***

2. The objections to claims 4, 5, and 12 are hereby withdrawn in light of Applicant's Amendment submitted 12 May 2003. Claim 1 is, however, still objected to because of the following informalities: the period at the end of line 2 should be removed and/or replaced with a colon or a comma. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. In light of Applicant's cancellation of claims 11 and 17, the rejections set forth in the previous Office action under 35 USC §112, second paragraph, are hereby withdrawn. Claims 10 and 18 are, however, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 10. Recitation of "a pattern definable as an image" renders the claim indefinite because it is unclear what the phrase "definable as an image" means.
- b. Claim 18. Recitation of the limitation "said elevated surface accumulation is definable as a symbol" renders the claim indefinite because it is unclear what the word "symbol" means in the context of the disclosure.

*Claim Rejections - 35 USC § 102*

4. Claims 1, 3-5, 8-10, 12, 15, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Guice (US 4,678,209).

a. Claim 1. Guice shows and discloses a die insert **20** having a front face **26** with pipe gripping teeth **32** and a generally parallel back face **22, 24**; textured relief **34** formed on the surface of the back face **22, 24**, for forming and engaging impressions in an opposing surface **14, 16** of a confining slip **12**, when forced against the opposing surface **14, 16**, to add skid resistance between the die insert **20** and the opposing surface **14, 16** of the slip **12** (see figures 1, 2, 4, and 5; column 3 line 39 – column 4 line 46).

b. Claim 5. Guice shows and discloses a die insert **20** having generally parallel first **26** and second **22, 24** faces on opposite sides, said die insert **20** comprising a first of the faces **26** textured with projecting teeth **32** for gripping pipe surfaces; the second face **22, 24** textured with surface depressions **34** to reduce the surface area in contact with the mating surface **14, 16** of die insert carrying slips such that more than a selected normal loading of the die insert **20** will coin an impression of the textured surface **22, 24** of the die insert **20** into the mating surface **14, 16** of the related die insert carrying slip **12**, for the purpose of reducing the tendency of the die insert **20** to slide on the slip **12** when the die insert **20** is carrying a substantial payload (see figures 1, 4, and 5; column 3 line 39 – column 4 line 46).

c. Claim 12. Guice shows and discloses a die insert **20** having generally parallel first **26** and second **22, 24** faces, said die insert **20** comprising a first of the faces **26** textured with projecting teeth **32** for gripping pipe surfaces; and the second face **22, 24** textured with

surface depressions **34** created to displace metal upward in the [vicinity] of the depression to present a small elevated surface accumulation of such limited effective collective load bearing area that the raised metal will be imbedded into the surface of the insert supporting surface **14, 16**, when subjected to a preselected amount of force perpendicular to the second face **22, 24**, to reduce the tendency for the insert **20** to slide on the insert supporting surface **14, 16** (see figures 1, 4, and 5; column 3 line 39 – column 4 line 46).

d. Claims 3, 8, and 15. Guice shows and discloses said texture relief **34** is achieved by a plurality of generally transverse scribe lines (see figures 1 and 4).

e. Claims 4, 9, and 16. Guice does not explicitly disclose said texture relief is achieved by acid etching of the surface of the back face. Nevertheless, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

f. Claim 10 (*as best understood*). Guice shows said textured surface **34** on said second face **22, 24** comprises a pattern definable as an image (see figure 4).

g. Claim 18 (*as best understood*). Guice shows said elevated surface accumulation **34** is definable as a symbol (see figure 4).

### ***Claim Rejections - 35 USC § 103***

5. Claims 2, 6, 7, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guice, as applied above, in view of Bee et al (US 5,971,086) (Bee). With regard to Claims 2, 6, 7, 13, and 14, Guice shows and discloses said textured relief **34** comprises a plurality of

generally transverse relief patterns, the relief representing surface depressions (see figure 4). Guice does not disclose said surface depressions of more than one one-thousandths inch. Bee, however, teaches surface depressions of more than one one-thousandths inch (two one-thousandths inch) so that the pipe die will still penetrate the surface of the pipe to maintain a positive grip while keeping the penetration of die teeth to a minimum. (see Bee column 2 lines 26-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made modify the textured relief surface of Guice by providing surface depressions of more than one one-thousandths inch in order to provide minimum penetration while still maintaining a positive grip as taught by Bee.

#### *Response to Arguments*

6. Applicant's arguments filed 12 May 2003 have been fully considered but they are not persuasive.

7. Applicant first argues that "[t]he Guice reference does not have a separate die and slip," and that the "slip is the die" and cannot "embed projections into the slip". The Examiner respectfully disagrees with this characterization of the Guice reference. As set forth in the previous Office action (paper no. 2, subsection 5a) as well as in the rejections above, Guice does in fact have a die **20** and a slip **12** which are separate and which is configured so that the die **20** may embed projections **34** into the slip. The fact that Guice refers to the die insert **20** as a "slip member" and also refers to the slip **12** as a "slip bowl" is irrelevant. Applicant's assertion in this regard is completely without merit.

8. Second, Applicant argues that “[n]owhere is it found that Guice anticipated the use of the textured surface as means to secure a die against vertical movement relative to a related slip.” Again, the Examiner respectfully disagrees. Column 4, lines 15-46 of the disclosure of Guice explicitly describes the textured surface **34** as a means to secure a die **20** against vertical movement relative to a related slip **12** (see also figures 1, 2, 4, and 5). Even assuming, *arguendo*, that Guice does not disclose the use of the textured surface described therein as means to secure a die against vertical movement relative to a related slip, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

9. Third, Applicant argues that “there is no slip and die interface.” The Examiner respectfully disagrees. The slip and die interface shown and disclosed by Guice exists where there is contact between slip surfaces 14 and 16 and die insert surfaces 22 and 24 (see especially figure 5).

10. Fourth, Applicant argues that Guice is fundamentally different from the present invention because the present invention makes “no effort . . . to prevent the wedging element (slip) from crushing pipe.” In response, the Examiner points out that the features upon which applicant relies (i.e., the slip is capable of transmitting crushing loads to the pipe) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). Further, it must be noted that Guice discloses the invention as claimed. The fact that it discloses additional structure and, consequently, additional functionality, not claimed in the instant application is irrelevant.

11. Lastly, as to Applicant's argument that the combination of Guice and Bee is improper because the combination eliminates the die/slip interface required by the present invention, the Examiner points to the response presented in paragraph 6 above.

12. Applicant's arguments in the final paragraph of Applicant's response (paper no. 3) fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In order to be considered as evidence of patentability, these arguments must be presented in a signed affidavit filed under 37 CFR 1.132.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952.

The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RMF  
July 22, 2003

  
**Lynne H. Browne**  
*Supervisory Patent Examiner*  
**Technology Center 3670**